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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,885	03/04/2002	Dean R. Brown	PWP0002/US/2	6454
33072	7590	02/16/2006	EXAMINER	
KAGAN BINDER, PLLC SUITE 200, MAPLE ISLAND BUILDING 221 MAIN STREET NORTH STILLWATER, MN 55082			FIDEI, DAVID	
		ART UNIT	PAPER NUMBER	
		3728		

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/090,885	BROWN, DEAN R.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David T. Fidei	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 January 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 5-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 a non-adhesive label is recited as trapped between the shrinkwrap and the side wall. In claim 5 a label is recited as adhesively affixed to shrinkwrap. These are a direct contradiction. Furthermore, since the label of claim 5 can include an adhesive, it is possible to have a device infringe claim 5 but not claim 1. Since a dependent claim must include all of the features of the independent claim from which it depends, this should never occur. Accordingly, the scope of the claims is unclear where it is not comprehensible if the label is to include adhesive for the application thereof or not.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and , 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muraoka (Patent no. 4,018,904) in view of Gray, Jr. (Patent no. 5,489126). Muraoka discloses a container 1 with a sidewall extending upward from the bottom and terminating in a rim with the sidewall tapering from top to bottom. A lid 4 releasably covers the container. An annular discontinuity 10 is disposed on the sidewall intermediate the top and bottom as shown in figure

1. A tubular layer of shrinkwrap 5 envelops the tapered sidewall 2 and the outer periphery of the lid. Perforations 22 and 23 permit removal of the shrinkwrap from the lid and rim. Since shrinkwrap, by its very name suggests, shrinks about the article retained when heated thereby retaining a similar co-formed shape, the wrap conforms to the shape of the discontinuity at 10. Should applicant disagree with this finding they should present evidence, or identify any evidence of record, demonstrating such is not the case.

The difference between the claimed subject and Muraoka resides in a non-adhesive label trapped between the shrinkwrap and sidewall. Gray, Jr. teaches that it is known to attach label to articles by trapping the label between the article and the outer surface of the shrinkwrap.

It would have been obvious to one skilled in the art at the time the invention was made to modify the container of Muraoka by including an adhesive free label between the shrinkwrap and sidewall, in order to provide bar cod for pricing or indicia for conveying product information.

As to claim 5, to use adhesive to attach the label to the shrinkwrap would have been an obvious expedient to one skilled in the art for the reason that adhesive labels are notoriously well known. To use an adhesive would have been within the level of ordinary skill in the art and obvious for the reason of holding the label in place while placed about object.

5. Claims 1 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando (Patent no. 3,976,795) in view of Karevaara (Patent no. 4,102,454) and Gray, Jr. (Patent no. 5,489,126) or Kaufman (Patent no. 6,247,612). The decision of the Board of Patent Appeals and Interference mailed November 18, 2006 is incorporated herein by reference. Where the combination of these references were found to render a container with a sidewall extending upward from the bottom and terminating in a rim with the sidewall tapering from top to bottom, a lid releasably covers the container and an annular discontinuity disposed on the sidewall intermediate the top and bottom was found to be prima facie obvious over Ando and Karevaara.

Page 6, first paragraph of that decision also determined that the shrinkwrap is torn by a consumer in a manner such that the shrinkwrap is separated from the lid, and yet clings to a portion of the sidewall.

It was further agreed the claimed container, *prima facie*, would have been obvious in view of Gray and Kaufman as these teachings would have led one of ordinary skill in the art to hold a label with instructions, identification and other information to the cup-shaped container.

As to claim 5, to use adhesive to attach the label to the shrinkwrap would have been an obvious expedient to one skilled in the art for the reason that adhesive label are notoriously well known. To use an adhesive would have been within the level of ordinary skill in the art and obvious for the reason of holding the label in place while placed about object.

#### ***Response to Arguments***

6. Applicant's arguments filed January 20, 2006 have been fully considered but they are not persuasive. Applicant argues the Ando has no features on the container sidewall to help trap film and that the annular features of Karevaara are used for stacking in which a handle is folded against a side wall that is completely silent regarding the use of a shrinkwrap film. It appears the decision of November 18, 2006 addressed applicant's concerns in this regard on page 6, last paragraph. Here it is reiterated the test for obviousness is what the prior art, taken as a whole suggests. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Accordingly, applicant remarks in this regard remain unconvincing.

As to the fact that Karevaara can not have any shrink wrap remaining clinging because this would interfere with deployment of the handle, it is not seen where this is germane to the claimed subject matter. All that the claim speaks of is removal around lid portion is fundamentally capable of the simple combination. Any further steps or acts performed on the modified combination suggested by the prior art is of no significance in as much as is claimed. For this reason it is believed the rejection should still be maintained

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The Official Fax number to file responses to this Office Action is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei  
Primary Examiner  
Art Unit 3728

Dtf  
February 14, 2006